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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/02/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,837

Applicant(s)

AOTA ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Withdrawn Rejections

1. The 35 USC 112 rejection of claims 1, 3 and 4 of record in Paper #7, Page 2, Paragraph #2 has been withdrawn due to the Applicant's amendment in Paper #8.
2. The 35 USC 102 rejection of claim 1 as anticipated by Ohara et al. of record in Paper #7, Page 3, Paragraph #4 has been withdrawn due to the Applicant's amendment in Paper #8.
3. The 35 USC 103 rejection of claims 2-4 over Ohara et al. of record in Paper #7, Pages 3 and 4, Paragraph #6 has been withdrawn due to the Applicant's amendment in Paper #8.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the extruded direction, the width of the plate, the length of the plate, and width direction must be shown or the features canceled from the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

5. The amendment filed May 13, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

supported by the original disclosure is as follows: “having a width and a length” and “extends beyond the at least one end portion of the width, in a direction of the width”.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1-13** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations “in an extruded direction”, “having a width and a length” and “extend beyond the at least one end portion of the width, in a direction of the width” in claim 1 are not clearly described in the specification. It is unclear to one skilled in the art to understand what you mean. What is an extruded direction? What is a width direction? Clarification is requested.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 1-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The recitations “the length extending in an extruded direction”, “at least one end portion of the width of the plate”, “in a thickness direction of the plate”, “extends beyond the at least one end portion of the width, in a direction of the width”, and “substantially in parallel” in claim 1 are deemed vague and indefinite. Clarification is requested.

The recitation “a face of one side of the plate, at at least one end portion of the width of the extruded frame member” in claim 2 is deemed vague and indefinite. Clarification is requested.

The recitation “the length extending in an extruded direction” in claim 3 is deemed vague and indefinite. Clarification is requested.

The recitations “in a thickness direction of said extruded frame member” and “which faces in a same direction as said face of the one side of the plate” in claim 4 are deemed vague and indefinite. Clarification is requested.

The recitation “said protrusion portion has an inner face of a part of said protrusion portion extending beyond the at least one end portion of the width, said inner face being opposite to an opposed face which faces in a same direction as said outer side of said plate, and wherein there is a gap between an extension of said outer side of said plate and said inner face, in the thickness direction” in claim 5 is deemed vague and indefinite. Clarification is requested.

The recitation “said at least one end portion has an end face which is exposed, and wherein said protrusion portion extends above said end face, and beyond said end face in the direction of the width” in claim 7 is deemed vague and indefinite. Clarification is requested.

The recitations “in the direction of the width” and “substantially the same” in claims 8 - 11 are deemed vague and indefinite. Clarification is requested.

The recitation “said protrusion portion extends beyond said at least one end portion in a direction of the width” in claim 10 is deemed vague and indefinite. Clarification is requested.

The recitation “said at least one end portion has an end face, wherein the triangular shaped groove is provided to the face of the outer side of the protrusion portion over the end face” in claim 12 is deemed vague and indefinite. Clarification is requested.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. **Claims 1-13** are rejected under 35 U.S.C. 102(e) as being anticipated by Ezumi et al. (6,354,483).

Ezumi et al. teaches an extruded frame member for use in friction stir welding, the extruded frame member including a plate having a width and a length (Fig. 1, #31), the length extending in an extruded direction, wherein: at least one end portion of the width of the plate of the extruded frame member is provided with a protrusion portion which protrudes from an outer side (Fig. 1, #35; also see col. 4, lines 59-61), in a thickness direction of the plate, from the plate of the extruded frame member, and extends beyond the at least one end portion of the width, in a direction of the width; and the protrusion portion (Fig. 1, #35) extends substantially in parallel to

the at least one end portion of the plate of the extruded frame member. Regarding **claim 2**, note a face of an outer side of the protrusion portion is provided with a triangular shaped groove (Fig. 1, #36). Regarding **claim 5**, the protrusion portion has an inner face of a part of the protrusion portion extending beyond the at least one end portion of the width, the inner face being opposite to an opposed face which faces in a same direction as the outer side of the plate, and wherein there is a gap between an extension of the outer side of the plate and the inner face, in the thickness direction (see col. 3, lines 38-42). Regarding **claim 7**, note at least one end portion has an end face which is exposed and wherein the protrusion portion (Fig. 1, #35) appears to extend above the end face and beyond the end face in the direction of the width. Regarding **claim 8**, note the protrusion portion (Fig. 1, #35) has two ends in the direction of the width, and wherein a distance between one end of the protrusion portion (Fig. 1, #35) and the triangular shaped groove (Fig. 1, #36), in the direction of the width, appears to be substantially the same distance between the other end of the protrusion portion (Fig. 1, #35) and the triangular shaped groove (Fig. 1, #36), in the direction of the width.

In regards to **claim 3**, Ezumi et al. teaches an extruded frame member for use in friction stir welding, the extruded frame member including a plate having a width and a length (Fig. 1, #31), the length extending in an extruded direction, wherein: a face of one side of the plate (Fig. 1, #31), at at least one end portion of the width of the extruded frame member, is provided with a triangular shaped groove (Fig. 1, #36). Regarding claim 4, note wherein the at least one end portion, a protrusion portion (Fig. 1, #35) is provided which protrudes from the face of the one side of the plate (Fig. 1, #31), in a thickness direction of the extruded frame member and the triangular shaped groove (Fig. 1, #36) is provided to a face of an outer side of the protrusion

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portion (Fig. 1, #35), which appears to face in a same direction as the face of the one side of the plate (Fig. 1, #31). Regarding **claim 9**, note the protrusion portion (Fig. 1, #35) has two ends in the direction of the width, and wherein a distance between one end of the protrusion portion (Fig. 1, #35) and the triangular shaped groove (Fig. 1, #36), in the direction of the width, appears to be substantially the same distance between the other end of the protrusion portion (Fig. 1, #35) and the triangular shaped groove (Fig. 1, #36), in the direction of the width. Regarding **claim 10**, note the protrusion portion (Fig. 1, #35) has two ends in the direction of the width, and wherein the protrusion portion (Fig. 1, #35) appears to extend beyond the at least one end portion in a direction of the width. Regarding **claim 11**, note a distance between one end of the protrusion portion (Fig. 1, #35) and the triangular shaped groove (Fig. 1, #36), in the direction of the width, appears to be substantially the same as the distance between the other end of the protrusion portion (Fig. 1, #35) and the triangular shaped groove (Fig. 1, #36), in the direction of the width. Regarding **claim 12**, note the at least one end portion has an end face, wherein the triangular shaped groove (Fig. 1, #36) is provided to the face of the outer side of the protrusion portion over the end face.

Regarding **claim 6**, it has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding **claim 13**, it has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Response to Arguments

12. Applicant's arguments filed in Paper #8 regarding the 35 USC 102 rejection of claim 1 as anticipated by Ohara et al. has been fully considered but is moot since the rejection has been withdrawn.

13. Applicant's arguments filed in Paper #8 regarding the 35 USC 103 rejection of claims 2-4 over Ohara et al. has been fully considered but is moot since the rejection has been withdrawn.

14. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297.


The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Catherine Simone
Examiner
Art Unit 1772

July 26, 2002


HAROLD PYON
SUPERVISORY PATENT EXAMINER
